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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,204	07/31/2001	Hideyuki Aoki	FUJH 18.876	3969
26304	7590	05/02/2005	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			LIN, WEN TAI	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,204

Applicant(s)

AOKI ET AL.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 are presented for examination.
2. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

Claim Rejections - 35 USC § 102

3. Claims 1, 4, 6-7 and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamentsky et al.[U.S. PGPub 20020065929].
4. Kamentsky was cited in the previous office action.
5. As to claim 1, Kamentsky teaches the invention as claimed including: an information distribution device [200, Fig.1 less 240 (the client terminal)], comprising:
 - a first storage portion [e.g., 210, Fig.1] for storing terminal information including an address of each terminal device belonging to a group constituted by a plurality of terminal devices [Abstract; paragraph 29; 2, 6, Fig.1];
 - a first receiving portion for receiving, from a terminal device belonging to said group [240, Fig.1], a distribution request including access information and distribution

destination information, said access information being required for accessing distribution information for distribution to all, some or one of said terminal devices belonging to said group, said distribution destination information specifying a distribution destination terminal device belonging to said group [paragraph 23; 1, Fig.1];

a second receiving portion for accessing said distribution information based on said access information included in a distribution request received by said first receiving portion, and for receiving the distribution information [5, 230, Fig.1];

a second storage portion for storing said distribution information received by said second receiving portion [230, Fig.1]; and

a first transmitting portion specifying an address of a distribution destination terminal device based on said distribution destination information included in a distribution request received by said first receiving portion, and said terminal information stored in said first storage portion, and for distributing to said specified destination terminal device said distribution information stored in said second storage portion [paragraphs 22-23].

6. As to claim 4, Kamentsky further teaches that the system further comprises a deleting portion for deleting said distribution information stored in said second storage portion after the distribution of said distribution information by said first transmitting portion [note that since the second storage portion is located at the bulk data server (230, Fig.1), deletion of previously stored distribution information is a must otherwise the server's local storage would be overflowed by information no longer in use].

7. As to claim 6, Kamentsky further teaches that said distribution request further includes additional information added to said distribution information, and said first transmitting portion distributes said additional information in addition to said distribution information [see paragraph 32 and Fig.4B, wherein a plurality of promotions (ID1 – IDn) are provided in the schedule].

8. As to claim 7, Kamentsky further teaches that said distribution request further includes a distribution time for specifying a time for distributing said distribution information, and said first transmitting portion distributes said distribution information at said distribution time [paragraph 42].

9. As to claim 9, Kamentsky further teaches that said first receiving portion receives said distribution request from said terminal device via another server device [paragraph 18; note that 240, Fig.1 shows that the promotion manager client is a NT/Unix client, an indication that the device is different from the set-top box].

10. As to claim 10, Kamentsky further teaches that said distribution information is either a program including a game program, said program and a license for said program, map information, or product information [paragraph 15].

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-3, 8 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamentsky et al.(hereafter "Kamentsky")[U.S. PGPub 20020065929], as applied to claims 1, 4, 6-7 and 9-10 above, further in view of Official Notice.

13. As to claims 2-3, Kamentsky teaches that the system as described is used for promoting advertisement of goods and services [paragraph 15]. Kamentsky does not specifically teach how the billing is carried out. That is, Kamentsky does not specifically teach that the system further comprising a third receiving portion for receiving a bill of charges from a device, said device billing for said distribution information charges when said distribution information is chargeable; and a second transmitting portion for transmitting said bill of charges received by said third receiving portion either to a terminal device which transmitted said distribution request or to a telecommunications carrier to which this terminal device subscribes.

However, Official Notice is taken that providing billing to the clients who requested a commercial advertisement through group mailing of scheduled information is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made that Kamentsky's promotion agent client (240, Fig.1) would receive a bill from Kamentsky's data center for the advertising activities because Kamentsky's system is set out for promoting commercial products, which obviously charges for services.

14. As to claim 8, Kamentsky does not specifically teach that said terminal device information stored in said first storage portion includes information for representing an information format displayable on a display portion of the terminal device, and wherein said information distribution device further comprises a conversion/filtering portion for converting or filtering said distribution information to a format capable of being displayed on a display portion of said terminal device, based on said information for representing said displayable information format.

However, Official Notice is taken that establishing device profile regarding capabilities of the various clients' devices for transmitting information in a displayable format is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the device capability in Kamentsky's viewership profiles [paragraph 20] for transmission because by doing so it would enable individuals

holding different types of devices to receive appropriate (in terms of content and format) promoting information [paragraph 41].

15. As to claims 11-13 and 15-20, Kamentsky teaches the invention substantially as claimed in claims 1, 4, 6-7 and 9-10 above. For features recited in claims 1, 4, 6-7 and 9-10, they are rejected for the same reasons set forth above. Kamentsky further teaches distributing the promotion information via multicasting mode [Abstract]. Kamentsky does not specifically teach registering the plurality of terminal devices with the information distribution device as a group for multicasting.

However, Official Notice is taken that forming an IP multicasting group through a registration process is well known in the art. It would have been obvious to one of ordinary skill in the art to register Kamentsky's targeted plurality of terminal devices as an IP multicast group, which is based on the well-known Internet Group Management Protocol (IGMP), because the IGMP protocol allows a multicast router to track the existence of multicast group members on local networks coupled to that router, thereby facilitating the maintenance of the group.

16. As to claim 14, Kamentsky further teaches that said distribution information is related to product information [paragraph 15].

17. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamentsky et al. (hereafter "Kamentsky")[U.S. PGPub 20020065929], as applied to claims 1-4 and 6-20 above.

18. As to claim 5, Kamentsky teaches a guaranteed delivery of the distributed information by retransmitting failed portion with TCP protocol when the receiving ends report failure of receiving the information to the bulk data server [paragraphs 52-53]. Kamentsky does not specifically teach transmitting notification, to the terminal device which transmitted said distribution request, of the fact that distribution has been completed.

However, sending a completion/failure notification to a requesting node is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to pass up the failure or success notification (from Kamentsky's bulk data server) to the original promotion requester because by doing so it would let the requester be aware of the fact that the scheduled completion time would be delayed when a previous transmitting attempt has failed [paragraph 54].

19. Applicant's arguments filed on 3/21/2005 for claims 1-20 have been fully considered but they are not deemed to be persuasive.

20. Applicant argues in the remarks that:

1. Kamentsky does not read on the claims (in particular claim 1) because client 240 of Fig. 1 is part of the targeted promotion delivery system 200, which the examiner equated to Applicant's "information distribution device", and therefore it cannot be a terminal that belongs to a group.

2. The rejection of claims 11, 17 and 20 based on reasons set forth in the rejection of claim 1 appears to be inappropriate because these claims relate to terminal device, while claim 1 is related to the distribution device of claim 1.

3. The examiner has failed to establish a prima facie case of obviousness under U.S.C. 103 because there is no suggestion or motivation for modifying Kamentsky.

21. Examiner respectfully disagrees with applicant's remarks:

As to point 1: it is noted that the examiner did not equate Kamentsky's targeted promotion delivery system 200 to Applicant's "information distribution device". Kamentsky lumps the referred "information distribution device" and the client terminal 240 together and calls it a targeted promotion delivery system 200 in Fig. 1 [see, e.g., paragraph 18]. The examiner simply pointed to the area close enough to indicate where the "information distribution device" resides in the overall system of Fig.1. On the other hand, Applicant's claim 1 does not clearly convey that the terminal device from which a distribution request is submitted should not be part of the information distribution "device" (note that a device itself can be a system or subsystem). By denoting now that Applicant's "information distribution device" is equivalent to Kamentsky's targeted

promotion delivery system 200 of Fig.1 less 240 of Fig.1, the confusion hopefully has been clarified.

As to point 2: it is noted that claim 1 includes the features: "a distribution request including access information and distribution destination information, said access information being required for accessing distribution information for distribution to all, some or one of said terminal devices belonging to said group, said distribution destination information specifying a distribution destination terminal device belonging to said group" which map well to the main features of claims 11, 17 and 20. The rest of the features such as "a registration portion ..." and "a transmitting portion ..." are simply inherent to a networked terminal, which are also inherent features of 240 of Fig.1.

As to point 3: it is asserted that all the 103 rejections based on Kamentsky and the Official Notice have established that the additional features other than those found in Kamentsky are well known, followed by proper motivations/suggestions that are in the knowledge generally available to one of ordinary skill in the art. It is Applicant's burden to particularly point out why and which reasoning or motivation/suggestion is not applicable.

For at least the above reasons, it is submitted that the prior art of record reads on the claims.

22. Because Applicants have failed to challenge any of the Examiner's "Official Notices" stated in the previous office action in a proper and reasonably manner, they are now considered as admitted prior art. See MPEP 2144.03

23. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and


(703)746-5516 for status inquires draft communication.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

April 26, 2005


4/26/05